

Nyhan et al. Application No. 09/900,674

Reply to Office Action

**REMARKS**

The Office Action dated September 2, 2005, and the references cited therein have been carefully considered. Claims 1-27 are presently pending. No claims currently stand allowed. Applicants have amended claims 8, 9 and 13 to remedy errors identified in Section 2 of the Office Action. Other claims have been modified to more clearly define the invention. In view of the claim amendments and remarks set forth herein below, the pending claims 1-27 are patentable over the prior art presently known to Applicants. Accordingly, Applicants request favorable reconsideration of the grounds for the previous rejection in view of the now pending claims. Please charge any fee deficiencies to Deposit Account No. 12-1216.

*Summary of the Grounds for the Prior Art Rejections*

1. **Sections 3 and 4:** Claims 1-7, 10-11, and 13-21 are rejected under 35 U.S.C. §102(e) as being anticipated by de Ment U.S. Pat. No. 6,728,755 (filed on September 26, 2000), hereinafter "the de Ment '755 patent";
2. **Sections 5 and 6:** Claims 8-9 and 22-24 are rejected under 35 U.S.C. §103(a) as being obvious over the de Ment '755 patent in view of Hamlin et al. U.S. Patent No. 6,477,504, hereinafter "the Hamlin '504 patent"; and
3. **Section 7:** Claims 12 and 25-27 are rejected under 35 U.S.C. §103(a) as being obvious over the de Ment '755 patent.

Applicants traverse each and every rejection of the presently pending claims over the prior art for at least the reasons set forth herein below.

*Detailed Remarks Responding To Prior Art Rejections*

Applicants traverse the rejection, in sections 3 and 4 of the Office Action, of claims 1-7, 10-11, and 13-21 under 35 U.S.C. §102(e) as being anticipated by the de Ment '755 patent. Applicants' claim 1 is directed to a method for conducting an on-line survey in association with presentation of an *on-line advertisement*. The original language of claim 1 recited "computer-readable instructions for displaying an on-line advertisement." Furthermore, Applicants have amended claim 1 to make clear the progression of related steps associated with delivery of an on-line survey solicitation. An ad server receives a request for an on-line advertisement to be downloaded to a browser client. In response an on-line survey solicitation is selectively presented to the browser client. The selective presentation of the solicitation

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comprises accessing information indicative of a past on-line survey solicitation performed on the browser client. The selective presentation step also includes *adding computer-readable instructions to the on-line advertisement* provided to the browser client that facilitate invoking decision-making steps regarding whether to present the on-line survey solicitation via the browser client.

The de Ment '755 patent discloses a survey management facility wherein a pop up survey is submitted to a user based upon the results of a criterion implemented by a routine (see, step/pop-check routine 210) invoked when a user invokes a web tool (see, step 205 of FIG. 2). In response to the user invoking a web tool, the pop-check routine is executed to determine whether to launch a pop-up survey. During step 212 a kill switch enables inactivation of the pop-up survey for a period of time. During step 216, the pop-check routine checks a cookie on the user's computer to see whether the user has seen the "survey" in the last six months. The cookie indicates whether the survey has been executed on the computer. The cookie does not specify when the *solicitation to take the survey* was last presented on the computer.

Applicants specifically traverse the rejection of claim 1 as anticipated by the de Ment '755 patent. Claim 1 includes multiple elements that are not disclosed in the de Ment '755 patent. While claim 1, in both its original/amended form, specifically recites an "on-line advertisement", the de Ment '755 does not disclose any advertisements. The term "advertisement" is not even mentioned in the de Ment patent. In the event that the rejection of claim 1 is not withdrawn, Applicants request specific identification of the teachings of survey solicitation-related instructions attached to an advertisement block provided to a client browser.

The grounds for rejecting claim 1 also improperly assert that the de Ment '755 patent discloses determining whether or not the user has previously been *solicited to take the survey*. In fact, de Ment '755 discloses accessing information indicative of a user *taking the actual survey*. Thus, step 216 of the de Ment '755 patent addresses assuring that a particular survey is not carried out for a period of time after completing the survey. Step 216 does not address limiting repetition of survey solicitation after a previous *solicitation* is presented to a user/computer. For at least this further reason claim 1, in both its original and amended form, is not anticipated by the de Ment '755 patent.

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Applicants traverse the rejection of independent claims 13 and 17 for at least the reasons set forth above regarding claim 1.

The rejection of claim 2 is also traversed. However, the rejection is moot in view of substantial changes to the elements recited in claim 2. Applicants traverse the rejection of claim 14 for at least the reasons provided above with regard to claim 1.

Applicants traverse the rejection of claims 3 and 4 since the de Ment '755 patent does not disclose receiving cookie data indicative of the on-line survey *solicitation*.

Applicants traverse the rejection of claim 5. Applicants have clarified their recited invention by expressly indicating the block of data sent to the browser client includes the *added computer-readable instructions*.

Applicants traverse the rejection of claims 6, 7, 10 for at least the reasons set forth for claim 1 from which these claims depend.

Applicants traverse the rejection of claims 11 and 16 for at least the reason set forth for claim 1. Applicants note that claim 11 specifically references an on-line *advertisement* which is not disclosed in the de Ment patent.

Applicants traverse the rejection of claim 15. While the claim recites inserting script into a downloaded advertisement. However, this aspect of the recited invention is not disclosed in the de Ment '755 patent.

Applicants traverse the rejection of claim 18 since de Ment patent does not disclose determining when the *solicitation* was last executed on the client.

Applicants traverse the rejection of claim 19 for at least the reasons set forth above for claim 1 (and claim 13 by reference).

Applicants traverse the rejection of claims 20 and 21 for at least the further reason that the de Ment patent does not disclose attaching script to an on-line advertisement

Applicants traverse the rejection, in sections 5 and 6 of the Office Action, of claims 8-9 and 22-24 under 35 U.S.C. §103(a) as being obvious over the de Ment '755 patent in view of the Hamlin '504 patent. Neither de Ment nor Hamlin discloses a *frequency parameter value* being a function of *time remaining/elapsed* in a campaign.

Applicants traverse the rejection, in section 7 of the Office Action, of claims 12 and 25-27 under 35 U.S.C. §103(a) as being obvious over the de Ment '755 patent. Regarding the

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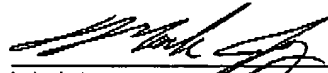
rejection of claim 12, Applicant notes that in the rejection of claim 12, the Office Action appears to assert that the recited invention concerns "an advertisement for a survey". Applicants note that their invention is directed to providing a solicitation to take a survey in association with a downloaded advertisement. The de Ment '755 patent does not disclose providing a survey solicitation in association with an advertisement and thus cannot render any of the pending claims, including claim 12, unpatentable.

Applicants traverse the rejection of claims 25-27 as obvious over de Ment. In particular, de Ment neither discloses nor suggests an ad server. In fact, the methods/system disclosed in de Ment do not even concern on-line advertisements. In the event that the rejection is not withdrawn, Applicants specifically request identification of disclosure within the de Ment reference of an ad server and advertisements provided via the ad server to a browser client.

#### *Conclusion*

For the above reasons, the above-amended claims are in proper form for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Mark Joy, Reg. No. 35,562  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson Avenue  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

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